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Paper No.

William Delaplaine Green
508 East 5th Street
Bethlehem PA 18015

MAILED

JUN 03 2011

OFFICE OF PETITIONS

In re Application of	:
William Delaplaine Green	:
Application No. 10/637,841	:
Filed: August 8, 2003	:
Title: TWO-CYCLE INTERNAL	:
COMBUSTION ENGINE	:

DECISION ON PETITION
PURSUANT TO
37 C.F.R. § 1.137(B)

This is a decision on the petition filed April 13, 2011, pursuant to 37 C.F.R. § 1.137(b), to revive the above-identified application.

This petition is **DISMISSED**.

An Office communication (first Office communication) was mailed on December 17, 2009, which required, *inter alia*, the submission of a marked up copy of a substitute specification. The mailing set a non-extendable one month period for response, and expressly withdrew a previously-made indication from the Office that the application contains allowable claims.¹ A response was received on January 19, 2010, and a marked up copy of the substitute specification was not submitted concurrently therewith. Consequently, an Office communication (second Office communication) was mailed on February 25, 2010, which reiterated the requirement for the submission of a marked up copy of a substitute specification. The second Office communication set an extendable one month period for response. No extensions of time under the provisions of 37 C.F.R. § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-

¹ See first Office communication, page 2. See also Office Action Summary of December 21, 2006, section 5.

identified application became abandoned on March 26, 2010. A notice of abandonment was mailed on October 28, 2010.

A petition pursuant to 37 C.F.R. § 1.137(a) was filed on December 21, 2010, and was dismissed via the mailing of a decision on February 14, 2011.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition, Applicant has submitted the petition fee and the proper statement of unintentional delay. It follows that the second and third requirements of Rule 1.137(b) have been satisfied. The fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.²

The present petition is not grantable because the first requirement of Rule 1.137(b) has not been satisfied. Petitioner did not submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.³ In order for the application to be revived, Petitioner must submit a reply which satisfies 37 C.F.R. § 1.137(b)(1) (i.e., a **marked up copy of the substitute specification**). The petition was not accompanied by this reply.

If reconsideration of this petition is desired, Petitioner may file a reply including a cover letter entitled "Renewed Petition

² See Rule 1.137(d).

³ See M.P.E.P. § 711.03(c).

pursuant to 37 C.F.R. § 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

If reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any future submission concerning this matter should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,⁴ hand-delivery,⁵ or facsimile.⁶ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.⁷

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.⁸ All other inquiries concerning examination procedures should be directed to the Technology Center.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

⁶ (571) 273-8300: please note this is a central facsimile number.

⁷ <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

⁸ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: William Delaplaine Green
8906 Camden Street
Alexandria, VA 22308-2715